

Appl. No.: 10/720,512
Atty. Docket No.: 1999B060/3
Amdt. dated July 9, 2008
Reply to Office Communication of June 30, 2008

REMARKS

Reconsideration and allowance of this application are respectfully requested.

Claims 14, 16, and 52-60 are currently pending. Claim 54, 55, and 56 are amended. Claims 15 and 51 are cancelled.

Upon indication of allowable subject matter, rejoinder of withdrawn claims 41-50 is requested.

The response due date for the Non-Final Office Action dated October 21, 2007 fell on a National Holiday. Applicants relied on 37 C.F.R. §1.7 for timely filing of the Response submitted January 22, 2008.

Notice Mailed May 14, 2008

The May 14th PTO Notice alleges Applicants' Jan. 22, 2008 Response was not fully responsive to the pending §112 rejections because the traversal was purportedly directed only to the enablement rejection and not the written description rejection. Applicants disagree, but submit the enclosed revised response with headers to more clearly state Applicants' arguments.

The third paragraph of Applicants' original response traverses the pending written description rejections. Applicants argued specific passages of the specification and the examples teach how to make the recited subject matter. The argument specifically stated "Applicants have described the recited subject matter at page 11, lines 13+ (identifying preferred MI endpoints), page 24, line 22 to page 25, line 20 (identifying methods generally, and page 29, lines 10-28 (identifying MFR endpoints.)"

If the Patent Office disagrees that the pending rejection is not traversed, the rejection should be maintained. But, fully responsive arguments traversing the written description were present.

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Rejection - 35 USC § 112 - Enablement

The Office Action rejects claims 14, 16, and 52-60 under 35 USC § 112, first paragraph for allegedly failing to comply with the enablement requirement. The Office Action alleges “no disclosure can be found” for methods of making the claimed subject matter. Applicants traverse these rejections.

The claimed subject matter is enabled by the present disclosure. Perforce, Applicants’ examples described five (5) compositions that correspond with the recited subject matter and methods for making the same. Per the attached declaration of Dr. Jean M Tancrede (“Tancrede Dec.”), each of these compositions was prepared and found to have an MFR_(230/2.16) over 250 dg/min and an MI greater than 78 as recited in pending claims. Applicants’ working examples disclose at least one method for making and using the claimed subject matter. See, e.g., Examples E, H, I, J, and K. These examples are reasonably correlated with the scope of the claimed subject matter. See Tancrede Dec., p.2. Other methods are described in the Detailed Description.

As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. §112 is satisfied. *See M.P.E.P. § 2164.01(b).* “Reasonable correlation” is not direct, parallel linking or hype-coordination. “A single working example in the specification for a claimed invention is enough to preclude a rejection which state that nothing is enables since at least that embodiment is enabled.” *See M.P.E.P. §2164.02.*

Applicants request that the present rejections be withdrawn.

Rejection - 35 USC § 112 – Written Description

The Office Action rejects claims 14, 16, and 52-60 under 35 USC § 112, first paragraph for allegedly failing to comply with the written description requirement. Applicants traverse these rejections.

Applicants’ detailed description supports the pending claims and shows that the Applicants were in possession of the recited subject matter. Applicants’ working examples describe compositions corresponding with the recited subject matter, *i.e.*, Examples E, H, I, J, and K. *See Tancrede Dec., p.2.* Moreover, Applicants have described the recited subject matter

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at page 11, lines 13+ (identifying preferred MI endpoints), page 24, line 22 to page 25, line 20 (identifying methods generally), and page 29, lines 10-28 (identifying MFR endpoints). Possession may be shown in a variety of ways including reduction to practice as in Applicants' Examples or by describing distinguishing identifying characteristics as on pp. 11, 24, and 35. *See MPEP §2163.*

In a voice message left the week of May 19, 2008, the Examiner clarified that this rejection is, at least in part, based on the fact that a description of "MI" and "MFR" limitations did not appear "together" or "for the same polymer". Applicants are unclear on the interpretation espoused by this voice message. A written description does not require *in haec verba* support for claim limitations or entire claims. *See MPEP §2163(B)* (stating "[T]here is no *in haec verba* requirement ... claim limitations must be supported in the specification through express, implicit, or inherent disclosure..."). A recitation of each specific embodiment, as suggested by the Patent Office, is not required to satisfy the written description requirement.

Once Applicants point out where and/or how the originally filed disclosure supports the amended claims, "the examiner has the initial burden of presenting evidence or reasoning why persons skilled in the art would not recognize in the disclosure a description of the [recited subject matter]". *See MPEP §2163.04.* Further, as Applicants' have submitted an affidavit supporting this response, the Examiner must analyze and discuss the affidavit in the next Office Action. *Id.*

Applicants request that the present rejections be withdrawn.

Rejection – 35 U.S.C. §132(a)

Applicants' proposed amendment to the specification was rejected under 35 U.S.C. §132(a) as introducing new matter to the disclosure. Applicants traverse for the reasons stated above.

Applicants believe this rejection is intertwined with the enablement rejections. The proposed specification amendment was intended merely to make the specification more clear. The requested amendment is withdrawn.

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Rejection – 35 USC § 102(e)

The Office Action rejects claims 14, 16, 52, 56, and 58 under 35 USC § 102(e), as being anticipated by U.S. Patent No. 6,407,171 to Agarwal et al. (“Agarwal”). Applicants traverse.

The Agarwal patent does not teach methods of preparing polypropylene-based adhesives prepared with metallocene catalysts in multiple reactors as recited in the amended claims. The Agarwal patent’s broad teaching of generic polypropylenes does not teach the claimed subject matter. Moreover, the Agarwal patent does not inevitably lead to the claimed subject matter and accordingly cannot be found to inherently teach the pending claims as amended.

Applicants request that the present rejections be withdrawn.

CONCLUSION

Applicants believe that the foregoing is a full and complete response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejections, and allowance of pending claims 14, 16, and 52-60 are requested.

The Commissioner is hereby authorized to charge counsel’s Deposit Account No. 05-1712, for any fees, including extension of time fees and excess claim fees, required to make this response timely and acceptable to the Office.

Respectfully submitted,

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